

Attorney Docket No.: SP02-260

REMARKS

Applicants appreciate the courtesy shown by the Office, as evidenced by the February 6, 2007, Decision by the Board of Patent Appeals and Interferences affirming the Examiner's rejections of the claims. The Examiner has rejected Claims 1-3, 4-6, 8-12, 14-24, and 26-31. Claims 7, 13, and 25 have been withdrawn from consideration and Claims 32-65 have been canceled. As such, Claims 1-31 remain in the case with none of the claims being allowed.

The February 6 Decision and the Office Actions issued by the Examiner on March 3 and October 24, 2005, have been carefully considered. After such consideration, Claims 1, 8, 10, and 31 have been amended, and a Request for Continuing Examination (RCE) is submitted herewith. Applicants respectfully request reconsideration of the application in light of the accompanying amendment and the remarks presented herein.

Claims 8 and 10 have each been amended to correct typographic errors.

Claims 1-3 have been rejected under 35 U.S.C. §102(e) as being anticipated by Yano et al. (U.S. Patent 6,740,590).

Applicants submit that independent Claim 1 has been amended in part to recite a process in which a slurry comprising a plurality of multi-component particles is provided, wherein each of the multi-component particles consists essentially of at least one of a mixed-oxide, an oxyfluoride, and an oxynitride composition. Support for the amendment is found, for example, in paragraph [0027] on page 8 of the specification.

Applicants submit that, in order to anticipate a claim, a reference must teach every aspect of the claimed invention. Accordingly, Applicants submit that Yano et al. do not teach providing a slurry comprising a plurality of multi-component particles, wherein each of the multi-component particles consists essentially of at least one of a mixed-oxide, an oxyfluoride, and an oxynitride composition. Instead, the reference teaches a slurry containing polymer particles electrostatically bonded to inorganic particles composed of metal oxides. See, for example, the Abstract; FIG. 2; and column 1, lines 14-17, of Yano et al.

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Applicants submit that, because the reference does not teach every aspect of amended independent Claim 1, the rejection of Claims 1-3 under 35 U.S.C. §102(e) as being anticipated by Yano et al. is successfully overcome.

Claims 4-6, 8-12, 14-24, and 26-31 have been rejected under 35 U.S.C. §103(a) as being obvious over Yano et al.

Claims 4-6, 8-12, 14-24, and 26-30 depend from independent Claim 1 and thus include the limitations of the base claim by reference. As previously presented, independent Claim 1 has been amended to overcome the rejection under 35 U.S.C. §102(e), and is now in condition for allowance. As Claim 1 is now allowable, the claims depending from this claim must also contain allowable subject matter. The rejection of Claims 4-6, 8-12, 14-24, and 26-30 under 35 U.S.C. §103(a) as being obvious over Yano et al. is therefore moot.

Claim 31 has been amended in part to recite a process in which a slurry comprising a plurality of multi-component particles is provided, wherein each of the multi-component particles consists essentially of at least one of a mixed-oxide, an oxyfluoride, and an oxynitride composition.

In order to establish a *prima facie* case of obviousness, a reference must either teach or suggest all of the claimed limitations. Accordingly, Applicants submit that Yano et al. neither teach nor suggest all of the limitations of amended Claim 1. The reference does not teach or suggest providing a slurry comprising a plurality of multi-component particles, wherein each of the multi-component particles consists essentially of at least one of a mixed-oxide, an oxyfluoride, and an oxynitride composition. Yano et al. instead teach a slurry containing polymer particles electrostatically bonded to inorganic particles.

Applicants further submit that the reference cited by the Examiner must be considered as a whole, including the parts that diverge or teach away from the invention. Accordingly, Applicants submit that Yano et al. actually teach away from the present claims.

Rather than teach providing a slurry having particles that consist essentially of at least one of a mixed-oxide, an oxyfluoride, and an oxynitride composition, the reference teaches that the use of abrasive inorganic particles such as metal oxides present problems by causing scratches on the polishing surface and infiltration of the inorganic particles into the polishing surface. See column 2, lines 41-45; and column 15, lines 3-39 of Yano

et al. Thus, the reference teaches *away* from the use of multi-component particles consisting essentially of at least one of a mixed-oxide, an oxyfluoride, and an oxynitrides, instead of providing some suggestion or motivation to use such particles in the absence of polymeric particles.

Applicants therefore submit that, because the reference fails to teach or suggest all of the limitations of the claimed invention and teaches away from the claimed invention, the rejection of Claim 31 under 35 U.S.C. §103(a) as being obvious over Yano et al. is successfully overcome.

In light of the amendments and remarks presented herein, Applicants submit that the case is in condition for immediate allowance and respectfully request such action. If, however, any outstanding issues remain unresolved, the Examiner is invited to telephone the Applicants' counsel at (607) 974-2112.

Respectfully submitted,

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